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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,341

08/31/2006

Ran Oren

32176

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67801

7590

10/19/2009

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EXAMINER

MASHACK, MARK F

ART UNIT

PAPER NUMBER

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10/19/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,341	<b>Applicant(s)</b> OREN ET AL.	
	<b>Examiner</b> MARK MASHACK	<b>Art Unit</b> 3773	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/22/2009</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This office action is in response to a communication dated 8/12/2009. Claims 1-2, 4-13, 15-20 are pending.

#### ***Continued Examination Under 37 CFR 1.114***

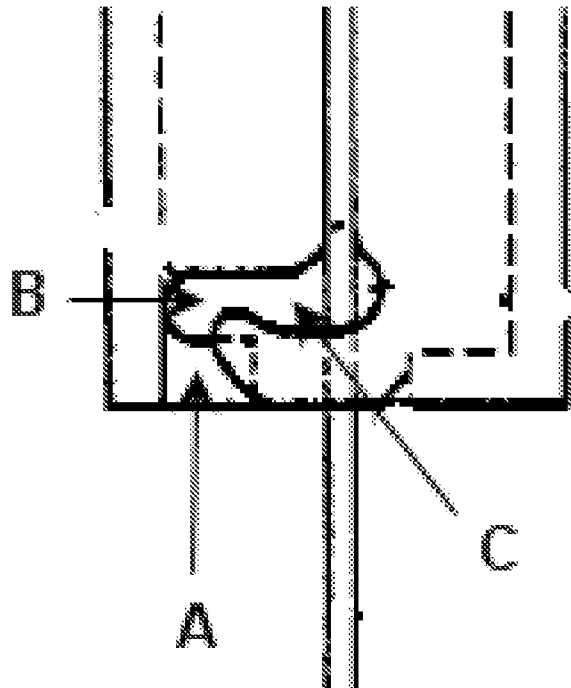
1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/12/2009 has been entered.

#### ***Response to Arguments***

2. Applicant argues that "if the Examiner considers the lower part of the slot in this reference to correspond to applicant's 'first section'... it does not extend along the outer surface of the outer surface of the elongated shaft of the recess... if the upper part of the slot 4 is considered by the Examiner as corresponding to the 'second section', it is to be noted that it does not lead from the juncture with the first section 'toward said distal of the elongated shaft', but rather extends in the radial direction." Examiner disagrees. Examiner provides an enlarged depiction of FIG 19C below as a reference. The first section (Element A) extends along the surface of the outer surface in order to receive the suture (Paragraph 76). The second section (Element C) extends toward the distal

Art Unit: 3773

end of the elongated shaft relative to the juncture (Element B) in order to secure the suture in the slot (Paragraph 79).



***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-2, 4-8** are rejected under 35 U.S.C. 102(b) as being anticipated by **Furusawa (US 2001/0041901)**.

**Furusawa** discloses an implement for manipulating a knotted suture comprising:

an elongated shaft **2** having a proximal end and a distal end engageable with a knotted suture (FIG 19);

a distal end with a recess **3** for receiving the knot of the suture;

said distal end has an open slot **4, 5** with a first section leading from said recess towards the proximal end and a second section leading from a juncture with said first section towards the distal end but terminating short of the end face. Said first slot section is a three dimensional object and hence has an infinite amount of plane, one of which is in a plane at an angle of 10-30 degrees relative to the longitudinal axis. Said second slot section additionally comprises a plane parrallel to the longitudinal axis of the elongated shaft (FIG 19C). The second slot section can be considered leading towards the distal end but terminating short since it widens towards the distal end after the inner surface of the junction. One segment of the plane of said second slot section is rotated *approximately* 90 degrees with respect to one segment of the plane of said first slot section (FIG 19A). The slots decrease from said juncture toward the distal since the rounded inner surface of the junction juts out into the slots.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3773

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Furusawa** in view of **Andreas et al. (US 5,797,929)**.

**Furusawa** discloses all of the claimed limitations except for the distal end of the elongated shaft being formed with an increased outer diameter with the slot extending through said distal end. However, **Andreas** discloses a similar implement **18** comprising an enlarged distal end **22** (FIG 3-4). All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Given the teachings of **Andreas**, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the implement of **Furusawa** with an enlarged distal end in order to facilitate capture and retention of the suture (Column 6, Lines 3-6).

8. **Claims 10, 13, 15-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Furusawa** in view of **Pierce (US 5,176,691)**.

**Furusawa** discloses all of the claimed limitations as stated above concerning the implement but does not explicitly disclose the tubular cutter with an annular cutting edge. However, **Pierce** discloses a similar implement **12** for surgically manipulating a knotted suture **10** comprising a tubular cutter **124** with a cutting edge (FIG 15 and Column 6, Lines 38-45). All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Given the teachings of **Pierce**, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the implement of **Furusawa** with a tubular cutter with a cutting edge. Doing so would facilitate the cutting of the suture especially in hard to reach places.

9. **Claim 11-12 and 20** rejected under 35 U.S.C. 103(a) as being unpatentable over **Furusawa** in view of **Pierce** as applied to claim **10 and 13** above, and further in view of **Dana et al. (US 2003/0109891)**.

**Furusawa** in view of **Pierce** disclose all of the claimed limitations as stated above except for the releasable latch for retaining said elongated shaft projecting distally from the tubular cutting member or the pivoting handles members to permit manipulating relative movement between the implement and the cutting member.

Art Unit: 3773

However, **Dana** discloses a similar implement with a cutting member **60** and a cutting member actuating device **40** which is biased in the retracted stage and advances the cutting member **60** to sever the suture. The cutting member actuating device **40** is actuated by pivoting relative to the housing **30** in order to advance the cutting member relative to the elongated member **50**. Therefore the cutting member actuating device **40** can be considered a latch that retains the elongated shaft **50** in an initial position wherein the distal end projects from the distal end of the tubular cutting member **60**. Additionally cutting member actuating device can also be considered a handle member which pivots relative to the housing which is the other handle member in order to manipulate relative movement between the elongated shaft and the cutting member. All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Given the teachings of **Dana**, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the implement of **Furusawa** in view of **Pierce** with a cutting member actuating device. Doing so would facilitate the cutting of the excess suture proximal to the knot.

10. **Claim 18-19** rejected under 35 U.S.C. 103(a) as being unpatentable over **Furusawa** in view of **Pierce** as applied to claim 17 above, and further in view of **Andreas**.



**Furusawa** in view of **Pierce** discloses all of the claimed limitations except for the distal end of the elongated shaft being formed with an increased outer diameter with the slot extending through said distal end. However, **Andreas** discloses a similar implement **18** comprising an enlarged distal end **22** (FIG 3-4). Said enlarged distal end **22** can be considered a “finger-piece” to facilitate handling of the distal end. All of the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Given the teachings of **Andreas**, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the implement of **Furusawa** with an enlarged distal end in order to facilitate capture and retention of the suture (Column 6, Lines 3-6).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK MASHACK whose telephone number is (571)270-3861. The examiner can normally be reached on Monday-Thursday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Mashack/  
Examiner, Art Unit 3773

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773